



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/727,287

12/03/2003

Scott W. Sanders

480062001800

4663

25224 7590 06/13/2007
MORRISON & FOERSTER, LLP
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013-1024

EXAMINER

STIGELL, THEODORE J

ART UNIT

PAPER NUMBER

3763

MAIL DATE

DELIVERY MODE

06/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/727,287

Applicant(s)

SANDERS, SCOTT W.

Examiner

Theodore J. Stigell

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 9-12, 14, 15, 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 13, 16 and 19-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Specification

The amendments to the Specification, filed 11/22/2006, are acknowledged and accepted.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are rendered indefinite because the Applicant is trying to claim method of use steps in a method of making claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8, 13, 16, and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Moorehead (6,478,783). Moorehead discloses an implantable access port comprising a housing (18) comprising a fluid chamber and an access aperture in fluid communication with the chamber, wherein the aperture is covered by a septum (20), a port stem (32) extending from the housing, wherein the port stem has an inner

Art Unit: 3763

lumen (78) forming a channel in communication with the chamber, and a marking (proximal 80) for providing guidance to a user for placement of a catheter over the port stem, the marking comprising at least a portion of a band at least partially disposed about the circumference of the port stem, wherein the marking is located on the port stem between a distal end of the port stem and a proximal end of the port stem, wherein the marking is positioned on the port stem such that if the catheter is aligned with a locking sleeve the catheter would not abut the housing. It is the Examiner's position that Moorehead discloses the methods recited by the Applicant.

Claims 1-8, 13, 16, and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Watson et al. (5,137,529). Watson discloses an implantable access port comprising a housing (12) comprising a fluid chamber and an access aperture in fluid communication with the chamber, wherein the aperture is covered by a septum (20), a port stem (62) extending from the housing, wherein the port stem has an inner lumen (64) forming a channel in communication with the chamber, and a marking (86) for providing guidance to a user for placement of a catheter over the port stem, the marking comprising at least a portion of a band at least partially disposed about the circumference of the port stem, wherein the marking is located on the port stem between a distal end of the port stem and a proximal end of the port stem, and the marking comprises contrast material (column 7, lines 27-30), wherein the marking is positioned on the port stem such that if the catheter is aligned with a locking sleeve the catheter would not abut the housing. It is the Examiner's position that Watson discloses the methods recited by the Applicant.

Claims 1, 8, 13, 16, and 19-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiita et al. (4,772,270). Wiita discloses an implantable access port comprising a housing (10) comprising a fluid chamber and an access aperture in fluid communication with the chamber, wherein the aperture is covered by a septum (70), a port stem (82) extending from the housing, wherein the port stem has an inner lumen (86) forming a channel in communication with the chamber, and a marking (102) for providing guidance to a user for placement of a catheter over the port stem, the marking comprising at least a portion of a band at least partially disposed about the circumference of the port stem, wherein the marking is located on the port stem between a distal end of the port stem and a proximal end of the port stem, wherein the marking is positioned on the port stem such that if the catheter is aligned with a locking sleeve the catheter would not abut the housing, and further comprising a locking sleeve (130). It is the Examiner's position that Wiita discloses the methods recited by the Applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 3763

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moorehead (6,478,783) or Wiita et al. (4,772,270). Moorhead and Wiita meets the claims limitations as described above in reference to claim 1 but fails to include that the marking comprise an ink contrast agent, a ribbon, a metallic ribbon or a shrink-wrap plastic.

Applicant has not disclosed that these specific components solve a state problem or are for any particular purpose. The instant specification does state that in general the marking does facilitate visualization for proper attachment of a catheter to the port stem. However, the specification does not indicate that these particular components as a marking are needed to the exclusion of other or similar forms of port stem markings. There is no disclosure that the claimed forms of markings are needed to perform this function and that the other form of markings would not perform equally well.

Therefore it appears that the port stem marker as described by Moorhead and Wiita et al or any form of port stem marker would perform equally well. Accordingly, the use of these forms on markings on the port stem is deemed to be an obvious design consideration, which fails to patentably distinguish over the prior art of Moorhead and Wiita.

Response to Arguments

Applicant's arguments with respect to claims 1-8, 13, 16 and 19-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theodore J. Stigell whose telephone number is 571-272-8759. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3763

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Theodore J. Stigell


NICHOLAS D. LUCCHESI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700